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09/815,261	03/22/2001	Yihua Chang	11302-1160 (44040-256044)	6495

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EXAMINER

ZALUKAEVA, TATYANA

ART UNIT	PAPER NUMBER
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1713

DATE MAILED: 11/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

cb10

# Office Action Summary

Application No.

09/815,261

Applicant(s)

CHANG ET AL.

Examiner

Tatyana Zalukaeva

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 29 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 7,8,10,12,14 and 16-41 is/are pending in the application.
- 4a) Of the above claim(s) 10,12,14 and 16-41 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 7 and 8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 7,8,10,12,14 and 16-41 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. Claims 1-6, 9, 13, 15 are cancelled by amendment, paper No.15. Claims 10, 12, 14, 16-41 are withdrawn from consideration.

***Response to Arguments***

2. Applicant's arguments with respect to claims 7 and 8 have been considered but are moot in view of the new ground(s) of rejection.

***Information Disclosure Statement***

3. The information disclosure statements filed 02/12/02, 02/26/02, 02/25/03, 2/20/03, fail to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language. It has been placed in the application file, but the information referred to therein has not been considered.

With regard to the IDS filed by Applicant that contains **480 !!!** references, Applicant is advised that the M.P.E.P. states the following with respect to large information disclosure statements:

*Although a concise explanation of the relevance of information is not required for English language information, applicants are encouraged to provide a concise explanation of why the English-language information is being submitted. Concise explanations (especially those that point out*

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*the relevant pages and lines) are helpful to the Office, particularly where documents are lengthy and complex and applicant is aware of a section that is highly relevant to patentability or where a large number of documents are submitted and applicant is aware that one or more is highly relevant to patentability.*

M.P.E.P. § 609. This statement is in accord with dicta from *Molins PLC v. Textron, Inc.*, 48 F.3d 1172 (Fed. Cir. 1995), states that forcing **the Examiner to find “a needle in a haystack” is “probative of bad faith.”** *Id.* at 1888. This case presented a situation where the disclosure was in excess of 700 pages and contained more than fifty references. *Id.* 1888. A cursory glance at the M.P.E.P. also provides more support for this position. In a subsection entitled “Aids to Compliance With Duty of Disclosure,” item thirteen states:

It is desirable to avoid the submission of long lists of documents if it can be avoided. Eliminate clearly irrelevant information and marginally pertinent cumulative information. If a long list is submitted, highlight those documents which have been specifically brought to Applicant's attention and/or are known to be of the most significance. See *Penn Yan Boats, Inc. v. Sea Lark Boats, Inc.*, 359 F.Supp 948 (S.D. Fla. 1972) *aff'd* 479 F.2d 1338 .

MPEP 2004. Therefore it is recommended that if any information that has been cited by Applicants in the previous disclosure statement, is known to be material for patentability as defined by 37 CFR 1.56, Applicant should present a concise statement as to the relevance of that/those particular documents therein cited. In the instant case only 35 out of 480 references are cited in the body of Specification and their relevance is discussed

4. It is noted here that Applicants did not response to Examiner's statement about IDS, but rather submitted new IDS with additional references.

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### ***Double Patenting***

5. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

6. Claim 7 is provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 6 of copending Application No. 09/815,259. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 7 and 8 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 16 of copending

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Application No. 09/815,169. Although the conflicting claims are not identical, they are not patentably distinct from each other because both claims call for absolutely identical polymer as a chief component and claim 16 of No. 09/815,169 additionally contains a divalent metal salt. However, the transitional phrase "comprising" in both cases leaves the "open door invitation" for any even major ingredients in even major amounts", and based on the proposed utility of the instantly claimed invention, a person skilled in the art would have found it obvious to include a divalent metal salt in order to form a triggerable cationic polymer .

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

9. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

10. Claims 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mandeville II et al (U.S. 6,007,803) or Fitzpatrick et al (U.S. 6,290,947) or Hart et al (U.S. 5,921,912) or Chasin et al (U.S. 4,151,148)

***Fitzpatrick and Mandeville III*** disclose ionic polymers as toxin-binding agents, which can copolymer comprising a monomer having a pendant ammonium group and a hydrophobic monomer. Both references exemplify 2[(methacryloyloxy)ethyl-] trimethyle ammonium chloride as such a monomer. Alkyl methacrylates are named as hydrophobic monomers. Both references do not expressly specify the embodiment

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presented by the instant claim 7, however, they disclose butyl acrylate and hexyl methacrylate as suitable hydrophobic monomers (US'803 col.7, lines 41-58;. US'947, col. 9, lines 11-28). Since the claimed 2-ethylhexyl methacrylate is the close structural homologue of the disclosed alkyl methacrylates, a person, skilled in the art would have found it obvious to utilize the claimed ethylhexyl substituent in lieu of prior art substituents in view of their closely related structures and the resulting expectation of similar properties and functions, as per *In re Wilder*, 563 F.2d 457, 460, 195 USPQ 426, 429 (CCPA 1977) (adjacent homologs and structural isomers); *In re Hoch*, 428 F.2d 1341, 1344, 166 USPQ 406, 409 (CCPA 1970) (acid and ethyl ester); *In re Druey*, 319 F.2d 237, 240, 138 USPQ 39, 41 (CCPA 1963) (omission of methyl group from pyrazole ring). Generally, some teaching of a structural similarity will be necessary to suggest selection of the claimed species or subgenus.

**Hart** discloses copolymers incorporating a hydrophilic cationic monomer subunit and a lipophilic nonionic monomer subunit or dispersions or emulsions of cationic polymers (abstract). Typical cationic monomer subunits include 2-acryloyloxyethyltrimethyl ammonium chloride (AETAC), 2-methacryloyloxyethyltrimethyl ammonium chloride (METAC), 3-methacrylamidopropyltrimethyl ammonium chloride (MAPTAC), diallyldimethyl ammonium chloride (DADMAC), acryloyloxyethyldimethylbenzyl ammonium chloride (AEDBAC) methacryloyloxyethyldimethylbenzyl ammonium chloride (MEDBAC), acrylamidopropyltrimethyl ammonium chloride (APTAC) (col.3, lines 14-52). Suitable

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lipophilic/nonionic monomer includes the species called for in the instant claim 7, i.e. butyl methacrylate and 2-ethylhexylacrylate (col.3, lines 53-65). Thus the reference discloses the possibility of all claimed comonomers but does not expressly exemplify them in combination as instantly claimed, a person skilled in the art would have found it obvious to employ the instant combination for the expected additive result based on the recognized functional equivalency of cationic comonomers with 2-ethylhexyl and butyl methacrylate. Absent a showing of unexpected results, no patentability is seen in using a mixture of lipophilic monomers, each of which is used for the same purpose by the prior art reference.

**Chasin** discloses crosslinkable cationic resin composition that comprises 30-80% of a non-functional monomer, such as lower alkyl acrylates, up to 15% by weight of acrylamide derivatives, and 1-15% of a cationic monomer that embraces the instantly claimed 2-methacryloyloxyethyltrimethyl ammonium chloride (METAC) (col.2, line 19 through col.3, line 57). The reference to Chasin does not specifically recite the combination as instantly claimed. However, since the prior art recites the combination that meets the requirement of the instant claims, the instant composition is deemed to be within the scope of obviousness. Furthermore, since the presently claimed composition does not exclude prior art additional ingredients, such as amide containing monomer, it would have been obvious to those skilled in the art to eliminate these ingredients along with their function, thus rendering obvious the instant claims.



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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tatyana Zalukaeva whose telephone number is (703) 308-8819. The examiner can normally be reached on 9:00 - 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (703) 308-2450. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0651.

October 28, 2003

Tatyana Zalukaeva  
Primary Examiner  
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A handwritten signature in black ink, appearing to read 'Zalukaeva', with a long, sweeping horizontal line extending to the right.